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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,547	01/23/2004	Hiroshi Tanaka	2091-0308P	4977

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EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2622

NOTIFICATION DATE	DELIVERY MODE
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10/25/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/762,547

Applicant(s)

TANAKA ET AL.

Examiner

John M. Villecco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 9-17 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The prosecution of this application has been transferred to Examiner John M. Villecco from the docket of Examiner Scott Egan. Any inquiry concerning this Office Action or earlier communications should be directed to the current Examiner of record. Current contact information is provided in the last section of this communication.

Response to Arguments

2. Applicant's arguments with respect to claim 1-5, 7, and 9-13 have been considered but are moot in view of the new ground(s) of rejection. Please see the new grounds of rejection presented on the following pages. **This action is non-final** due to the new grounds of rejection which was not necessitated by amendment.

3. Additionally, applicant has added new claims 14-17 that do not appear to be supported in the specification. Please see the new grounds of rejection for claims 14-17.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5. Claim 4 is objected to because of the following informalities:

- In line 2 of claim 4 applicant recites the phrase “a predetermine size”. This appears to be a typographical error and that the applicant meant to use the phrase – a predetermined size –.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Regarding claims 14 and 15, which are dependent upon claims 1 and 11, respectively, applicant has claimed “wherein the printer notifies a user, at a print order reception apparatus connected to the printer, of a print charge and time necessary for printing”. Applicant states that page 40, lines 8-20 provides support for this amendment. After reviewing this section, it is clear that the digital camera is connected to a print order reception apparatus and that the print order reception apparatus is connected to printer. However, the print order reception apparatus only communicates with the camera (1). The specification merely states that “the print order reception apparatus may display a printing charge and time necessary for printing to the user”.

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Firstly, this statement appears to be claiming that the print order reception apparatus displays the printing charge and time necessary for printing. This does not mean that the printing charge and time necessary for printing are displayed by the camera. Secondly, this section merely states that the print order reception apparatus displays a printing charge and time necessary for printing. It does not disclose that the printer notifies a user of the printing charge and time necessary for printing, as claimed. For these reasons this newly added claim language constitutes new matter.

9. As for claims 16 and 17, which are dependent upon claims 1 and 11, respectively, applicant has claimed “wherein a service is selected at the digital camera from a service menu of each store at which a print is received”. Applicant states that page 41, lines 5-13, provides support for this amendment. However after reviewing this section, the *image server* provides the operation screen to the digital camera, not the printer. See page 40, line 21 to page 41, line 4. Therefore, since the parent claims (claims 1 and 11) disclose that the printer provides the operation screen, this is clearly a different embodiment. Additionally, since there was never an embodiment disclosed in which a printer and a printer server provide an operation screen to a user of the digital camera, this newly added claim language constitutes new matter.

10. Claims 1-5, 7, and 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. Regarding independent claims 1 and 11-13, applicant has amended the claims to include the limitations of claim 6 of the original claims. After a thorough review of the specification, the

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examiner cannot determine how the logo displayed on the operation screen acts as an operation component for operating the printer as content to be browsed. Surely enough, the logo is displayed on the operation screen (see page 6, lines 12-16 of the specification), but the logo is not used as an operation component for operating the printer as content to be browsed. The logo is simply displayed on the screen, but has no function in operating the printer as content to be browsed. As page 6, lines 12-16 merely describes that the logo can be an operation component without any further details as to how the logo is operated as an operation component, the examiner is of the opinion that one of ordinary skill in the art would have to undertake undue experimentation to make and use the invention. Furthermore, this little amount of information provided in the specification would not enable one of ordinary skill in the art to make a logo an operation component for operating the printer as content to be browsed. This is proven by the fact that no other prior art has been found that describes this situation. As per *In re Wands*, (see section 2164.01 of the MPEP), based on the *In re Wands* factors, the examiner is of the opinion that one of ordinary skill in the art would be forced to undertake undue experimentation in order to make and/or use the invention. Of particular note are factors (C) State of the prior art, (D) The level of one of ordinary skill, (F) The amount of direction provided by the inventor and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. When considering each of these factors, the examiner is of the opinion that one of ordinary skill would not be enabled to make and/or use the invention.

12. Claims 2-5, 7, 9, 10, and 14-17 are rejected based on their dependency on claims 1 and 11, respectively.

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13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claims 9 and 10 recite the limitation "the server" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. **Claims 1-3, 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski et al. (U.S. Patent No. 7,038,714).**

18. Regarding *claim 1*, Parulski discloses a camera connected to a printer in which information stored in the printer is sent to the camera for display to control operation of the printer. More specifically, Parulski discloses a printer (digital printer, 400), which provides to the digital camera (electronic camera, 300) an operation screen including an operation component (Figures 6A-6Q) for operating the printer (digital printer, 400) as content to be

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browsed. As discussed in column 5, lines 5-65, the printer GUI is controlled by the user interface portion of the printer firmware memory (428) and the printer GUI is displayed on the camera LCD image display (332). Additionally, Parulski discloses that the digital camera (electronic camera, 300) includes a browsing means (interpreted by the examiner to be either the display (332) or the image processor (320) since both are used in aiding the user in browsing data) for browsing the content, a display screen (camera LCD image display, 332) for displaying the operation screen as content to be browsed, and operation means for receiving an instruction used for operating the printer (the users selects an operation using the printer controls, which is inherently sent to the camera for display by the camera display, thus the printer interface (322) would inherently receive the instruction for operating the printer via the operation screen). Furthermore, the printer (digital printer, 400) provides to the digital camera (electronic camera, 300) the operation screen comprising only an image including the operation component as the content to be browsed (See Figures 6A-6Q and col. 5, lines 5-65). In addition, the operation component includes all of a button for selecting an operation command included in the operation screen (Fig. 6G) and characters comprising the operation command (Figure 6H).

19. As for **claim 2**, Parulski discloses that the camera (electronic camera, 300) includes a storage means (memory card, 330) and control means (control processor, 320) for displaying images from the memory card (330) for printing. See Figures 6C and 6E and column 7, line 60 to column 8, line 20. Although the printer is used to select image data, the examiner believes that the claim language is broad enough to be read on “for selection from the image data”.

20. With regard to *claim 3*, when a user of the device in Parulski indicates that they are ready for selection of image data via the operation means, the control means displays images for the user to select. See column 7, line 60 to column 8, line 20.

21. Regarding *claim 9*, Parulski discloses an embodiment in which the camera and printer are connected to each other using wired connection (interface cable, 342').

22. As for *claim 11*, Parulski discloses a camera connected to a printer in which information stored in the printer is sent to the camera for display to control operation of the printer. More specifically, Parulski discloses a printer (digital printer, 400), which provides to the digital camera (electronic camera, 300) an operation screen including an operation component (Figures 6A-6Q) for operating the printer (digital printer, 400) as content to be browsed. As discussed in column 5, lines 5-65, the printer GUI is controlled by the user interface portion of the printer firmware memory (428) and the printer GUI is displayed on the camera LCD image display (332). Additionally, Parulski discloses that the digital camera (electronic camera, 300) includes a browsing means (interpreted by the examiner to be either the display (332) or the image processor (320) since both are used in aiding the user in browsing data) for browsing the content, a display screen (camera LCD image display, 332) for displaying the operation screen as content to be browsed, and operation means for receiving an instruction used for operating the printer (the users selects an operation using the printer controls, which is inherently sent to the camera for display by the camera display, thus the printer interface (322) would inherently receive the instruction for operating the printer via the operation screen). Furthermore, the printer (digital printer, 400) provides to the digital camera (electronic camera, 300) the operation screen comprising only an image including the operation component as the content to be browsed (See

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Figures 6A-6Q and col. 5, lines 5-65). In addition, the operation component includes all of a button for selecting an operation command included in the operation screen (Fig. 6G) and characters comprising the operation command (Figure 6H). Parulski discloses that the camera (electronic camera, 300) includes, an imaging means (image sensor, 314), a storage means (memory card, 330) and control means (control processor, 320) for displaying images from the memory card (330) for printing. See Figures 6C and 6E and column 7, line 60 to column 8, line 20. Although the printer is used to select image data, the examiner believes that the claim language is broad enough to be read on "for selection from the image data". Furthermore, when a user of the device in Parulski indicates that they are ready for selection of image data via the operation means, the control means displays images for the user to select. See column 7, line 60 to column 8, line 20.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. **Claims 4, 7, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. (U.S. Patent No. 7,038,714).**

25. Regarding *claim 4*, as mentioned above in the discussion of claim 1, Parulski alone discloses all of the limitations of the parent claim. Additionally, it is inherent that the display information provided by the printer firmware memory (428) has a predetermined size and layout.

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However, Parulski fails to specifically disclose that the digital camera displays the operation screen on the display screen by reducing or enlarging the operation screen according to its size.

However, Official Notice is taken as to the fact that it is well known in the art to reduce or enlarge an image to fit a display screen after it has been transferred from an external device.

This allows the transferred image data to be fit to the display screen. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce or enlarge the screen sent from the printer firmware memory (428) so that it is made to fit the display screen of the camera.

26. As for *claim 7*, as mentioned above in the discussion of claim 1, Parulski alone discloses all of the limitations of the parent claim. However, Parulski fails to explicitly disclose that the operation means comprises at least one of a key or button. Although Parulski discloses the use of buttons (394, 396, 398) on the camera for selecting, Parulski discloses that when connected to the printer, the buttons on the printer are used to select images. Parulski, however, discloses an embodiment in which the camera is connected to the printer using an interface cable (342'). This constitutes an embodiment in which the camera is located remote from the printer. Clearly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera buttons (394, 396, 398) to select the images, as the camera may be remotely located from the printer. Furthermore, Official Notice is taken as to the fact that it is well known in the art to operate a camera connected to a remote device to select and send commands to the remote device. Therefore, it would have been obvious to one of ordinary skill in the art to enable the camera of Parulski to select an operation to be carried out using the printer using the controls

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on the camera instead of the controls on the printer so that the operations and images can be selected when the camera is remotely located from the printer.

27. With regard to *claims 12 and 13*, please see a discussion of claim 1 or 11, respectively, regarding the limitations found in claims 1 and 11. As per the limitations of claims 12 and 13, Parulski discloses that the image processor in the camera (320) can be used to compress and decompress images (col. 5, lines 15-25). Parulski, however, fails to specifically disclose that if the operation screen is compressed image data the compressing/decompressing means decompresses the compressed operation screen. Given the disclosure in Parulski of compressing and decompressing the image data, one of ordinary skill in the art would have found it obvious to provide compressed operation screen data from the printer to the camera. It is well known in the art that compressing image data provides for less image data for storage and transfer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera of Parulski to decompress compressed operation screens sent from the printer so that storage memory in the printer is conserved and the time for transfer is lessened.

28. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. (U.S. Patent No. 7,038,714) in view of Shindo et al. (U.S. Patent No. 6,693,665).**

29. Regarding *claim 10*, as mentioned above in the discussion of claim 1, Parulski discloses all of the limitations of the parent claim. However, Parulski fails to disclose that the digital camera and printer are wirelessly connected. Shindo, on the other hand, discloses that it is well known in the art to wirelessly connect a camera to a printer. More specifically, page 8, lines 3-4 of Shindo disclose that the electronic camera (2) can be connected to the connection base (3)

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wirelessly. One of ordinary skill in the art would recognize that wireless connection provides for a greater freedom of access and less wires. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to wirelessly connect the camera of Parulski with the printer so that the user is afforded a greater amount of freedom or access and less wires.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/762,547

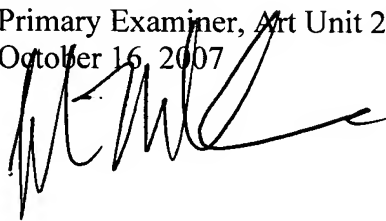
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John M. Villecco

Primary Examiner, Art Unit 2622

October 16, 2007

A handwritten signature in black ink, appearing to read 'J. M. Villecco', written over the printed name and date.